

## **Remarks**

Claims 1-17, 19, 20, 23-27, 29 and 31 are pending in this application. By this paper, Applicants have amended claims 5, 6, 13, 14, 16, 29 and 31.

### ***Reissue Applications***

Applicants are not aware of any prior or concurrent proceedings in which Patent No. 6,010,174 is or was involved, other than this reissue application no. 10/037,280. These proceedings would include interferences, reissues, reexaminations, and litigation. Applicants acknowledge and appreciate the Examiner's reminders of this continuing obligation and that set forth in 37 C.F.R. § 1.56 to timely apprise the office of any information which is material to patentability of the claims under consideration in this reissue application.

### ***Claim Rejections - 35 U.S.C. § 112***

The Examiner has rejected claims 6-7, 13-14, 29 and 31 under 35 U.S.C. § 112, second paragraph.

Claim 6 has been amended as illustrated below to recite a first pivotal attachment. Support for this change is provided in Figures 2, 3, 6, and 7 and the accompanying text beginning at column 2, line 49.

6. (Currently Amended) The visor of claim 5, wherein the torque control defines a first pivotal attachment to said rod, and the structure projecting from the visor body at least partially circumscribes said rod and defines a second pivotal attachment to said rod, wherein at least one of said pivotal attachments is slidably engaged to said rod, and said second pivotal attachment is slidably engaged with said rod.

Claims 13 and 14 have been amended to depend from claim 6 which recites a first pivotal attachment.

Claim 14 has been amended to remove the word component.

Claim 29 has been amended as illustrated below to recite a first pivotal attachment. Support for this change is provided in Figures 2, 3, 6 and 7 and the accompanying text beginning at column 2, line 49.

29. (Currently Amended) A sliding sun visor comprising:

a rod assembly including a longitudinally extending rod, a torque control pivotally attached to said rod defining a first pivotal attachment to said rod, said first pivotal attachment being substantially coaxial with said longitudinal rod, and a guide fixed to and extending from one surface of said torque control, said guide including a pair of opposing legs extending therefrom defining a longitudinal slot therebetween; and

a visor body including a longitudinally extending bore for receiving said rod allowing said visor body to slide axially with respect to said rod, said longitudinally extending bore being substantially coaxial with said rod; said visor body also including a longitudinally extending track slidably engaged between said opposing legs of said guide and received within said longitudinal slot, said track forming a substantially enclosed longitudinally extending passage adjacent one surface of said visor body, said passage being shaped to receive a portion of said guide in a sliding engagement; whereby upon moving the visor body longitudinally along said rod, said track slides relative to said guide.

Claim 31 has been amended as illustrated below to remove the reference to “a substantially enclosed longitudinally extending passage”, so that claim 31 now requires “an at least partially enclosed longitudinally extending passage.” Support for this change is provided in Figure 2, 3, 6 and 7 and the accompanying text beginning at column 2, line 49.

31. (Currently Amended) A sun visor assembly comprising:

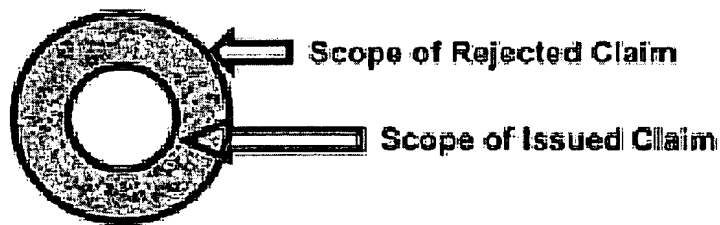
a rod assembly including a longitudinally extending rod having an elbow formed therein, a torque control pivotally attached to said rod in a non-slidable manner, and a guide fixed to one surface of said torque control and including a pair of opposing legs extending therefrom; and

a visor body including a longitudinally extending bore for receiving said rod, said bore slidable along said rod between said torque control and said elbow, and a longitudinally extending track, said pair of opposing legs of said guide forming ~~a substantially~~ an at least partially enclosed longitudinally extending passage adjacent one surface of said visor body, said passage being shaped to receive a portion of said track in a sliding engagement; whereby upon moving the visor body longitudinally along said rod, said track slides relative to said guide.

### *Recapture*

The Examiner has rejected claims 5-17, 19-20, 23-27, 29 and 31 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which a present reissue is based.

The Examiner refers to the decision in *Ex parte Eggert*, and Drawing 1 (copied below) of *Eggert* in the rejection of claims. 67 USPQ2d 1716, 1717 (Bd. Pat. App. & Interf. 2003).



**Drawing 1**

The Examiner recites:

[[n]]ote that two terms are central: 1) surrendered subject matter, a claim surrendered to the public as not patentable, represented by the outer circle, and 2) the shaded area of the drawing 1, which is sometimes referred to a [sic] the surreder limitation.

Non-final Office Action of April 29, 2004, page 3.

The Examiner's characterization of *Eggert* is incorrect. The shaded area is not the surrender limitation. According to *Eggert*,

the surrendered subject matter is the outer circle of Drawing 1 because it is the subject matter appellants conceded was unpatentable. The subject matter of the shaded area was not subject to the administrative examination process as the examiner was never directly presented with a claim which fell within the scope of the shaded area. Thus, appellants have never conceded that a claim falling within the scope of the shaded area of Drawing 1 is unpatentable and therefore, in our view, such subject matter is not barred by the recapture rule.

67 U.S.P.Q. 2d at 1717.

Likewise, the presented claims are of subject matter that was not subject to the administrative examination process and Applicant has never conceded that a claim falling within the scope of shaded area of Drawing 1 is unpatentable. Therefore, the rejected claims are not barred by the recapture rule.

According to the Examiner, the limitations of canceled claim 1,

are not subject to reissue and must be included in any reissue claim in this application...Specifically, relating to the claims of this application, claims 5 and 31 omit the limitation "said tracking forming a substantially enclosed longitudinally

extending passage adjacent one surface of the visor body". Claim 16 omits that it is the track that forms the passage and the passage receives the guide. Until such limitation is added to these claims, the recapture rejection will continue to apply and no reissue patent can be granted.

Non-final Office Action of April 29, 2004, pages 3-4.

Referring again to *Eggert*, the Board further explained Drawing 1.

Appellants' decision not to appeal the examiner's rejection of claim 1 (once amended) but to amend the claim and attempt to define narrower, patentable subject matter constitutes an irrevocable admission that a claim of that scope, the outer circle in Drawing 1 and broader, is unpatentable. Appellants had their chance to test the correctness of the examiner's rejection by way of appeal to this Board and chose not to do so. Appellants therefore cannot retreat all the way through the shaded area of Drawing 1 in this reissue and revisit that issue. Thus, claim 1 (once amended) constitutes surrendered subject matter under the "reissue recapture rule," but the issued claim does not.

67 U.S.P.Q.2d at 1718.

The rejected claims are not equal in scope to the surrendered claim, nor are they broader than the surrendered claim. Therefore, the surrendered claims are within the shaded area of Drawing 1 through which the Applicant can attempt to obtain reissued claims.

The Board further discussed Drawing 1 by providing examples.

For example, if an outer circle claim contains elements ABC and the inner circle claim contains elements ABCDEF, a reissue applicant cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside the outer circle (e.g., AB, BC, ABCBR [FN2] , etc.). However, it is our view that the reissue recapture rule is not invoked for claims directed to elements ABCX, ABCDBR, ABCEF, ABRBCDEF. In other words, the focus for determining the reach of the reissue

recapture rule should be the claim from which the issued claimed directly evolved, not the issued claim itself.

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FN2. The subscript BR designates a broader element, thus element CBR is broader than element C.

*Eggert*, 67 U.S.P.Q.2d at 1718.

If the surrendered limitation is represented by ABC, then the rejected claims can be represented by ABCBRX. Claims 5, 16 and 31 are represented by these elements because X represents the narrowing limitation of the pair of opposing legs and CBR represents the track, which is broadened in these claims by not identically reciting the limitation of the longitudinally extending passage as recited in surrendered claim 1. Although element C is broadened, it is not outside the circle because it includes narrowing limitation X and therefore is not as broad or broader than the surrendered claim. Therefore, the recapture rule does not apply.

In regards to claim 29, claim 29 includes all of the limitations of canceled claim 1 and includes further narrowing limitations such as the pair of opposing legs extending from the guide and defining a longitudinal slot. Therefore, claim 29 is similar to the example ABCX and therefore does not invoke the recapture rule.

According to the Board,

[t]he recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were canceled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are *narrower* in scope than the canceled claims.

*Eggert* 67 U.S.P.Q.2d at 1724, *Ball Corp. v. United States*, 729 F.2d 1429, 1435, 221 U.S.P.Q 289, 294 (Fed. Cir. 1984).

The Board in *Eggert* reviewed the applicable case law regarding the recapture rule and summarized the holding in *Mentor Corp. v. Coloplast, Inc.*, as:

a reissue claim does not avoid the recapture rule when the reissue claim has been (1) broadened relative to the original patent claims by omitting a limitation expressly added and relied upon by the patentee in order to obtain the patent in favor of language which the patentee had conceded during prosecution of the patent application was met by the prior art; and (2) not narrowed in any material respect compared with the broadening.

67 U.S.P.Q.2d at 1724 to 25; *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996, 27 U.S.P.Q.2d 1521, 1525 (Fed. Cir. 1993).

The Board in *Eggert* further reviewed the steps and test applicable to the recapture rule.

“The first step in applying the recapture rule is to determine whether and in what 'aspect' the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect.” “The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter.” To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and amendments made to the claims in an effort to overcome a prior art rejection. (Citations omitted.)

67 U.S.P.Q.2d at 1725; quoting *In re Clement*, 131 F.3d 1464, 1468-69, 45 U.S.P.Q.2d 1161, 1164 (Fed. Cir. 1997).

The Board in *Eggert* summarized the applicable test for recapture:

(1) if the reissue claim is as broad as or broader than the canceled or amended claim [the surrendered subject matter] in all aspects, the recapture rule bars the claim; (2) if it is narrower [than the surrendered subject matter] in all aspects, the recapture

rule does not apply, but other rejections are possible; (3) if the reissue claim is broader [than the surrendered subject matter] in some aspects, but narrower [than the surrendered subject matter] in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

67 U.S.P.Q.2d at 1726; citing *Clement* at 1469-70, 45 U.S.P.Q.2d at 1165.

Independent claims 5, 9, 16, 29 and 31 are all narrower in aspects germane to the prior art rejection, by the guide including a pair of opposing legs.

The reissue claims now presented do not impermissibly recapture surrendered subject matter.

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

MPEP § 1412.02. Although the subject matter of original claim 1 was *cancelled*, “[t]o determine whether an applicant *surrendered* particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.” [Emphasis added] *Clement* 131 F.3d at 1469, 45 USPQ2d at 1164. Accordingly Applicants may present claims that are broader *vis-à-vis* the original claims by omitting limitations from the original claims, even if the omitted subject matter was cancelled, as long as the omitted subject matter was not surrendered.



Claim 5 includes the subject matter of original claim 1 except for “said track forming a substantially enclosed longitudinally extending passage adjacent one surface of said visor body.”

Claim 5 is a reissue claim that is broader in scope in some aspects but narrower in others *vis-à-vis* claims canceled from the original application to obtain a patent. Claim 5 avoids the effect of the recapture rule because claim 5 is broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). Claim 5 is narrower with respect to the guide by including the pair of opposing legs spaced transversely away from the rod and the longitudinal slot - an aspect germane to the prior art rejection. Claim 5 is also narrower with respect to the track than original claim 1 because “the track cooperates longitudinally between the pair of opposing legs of said guide in a sliding engagement within the slot.”

Claim 5 is broader by omitting the longitudinally extending passage limitation of original claim 1. The passage limitation of original claim 1 was not relied upon to distinguish over the prior art in the prosecution of the patent, nor were arguments made that the passage limitation distinguished the original claims over the prior art. This feature was in the canceled claim, but not surrendered. Accordingly, Applicants should not be estopped from broadening and narrowing the claimed subject matter of the track, because the passage limitation of the track was not relied upon for reasons of patentability. Unlike *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1372 (Fed. Cir. 2001), wherein “the reissued claims were not narrowed in any material respect compared with their broadening,” amended claim 5 is narrowed materially in comparison to its broadening. The narrowing limitations to the track are directly related to the broadening aspects of the track of claim 5; therefore *Pannu* does not apply, and amended claim 5 overcomes the recapture rejection.

Claim 6-15 depend from claim 5 and therefore overcome the recapture rejection for at least the reasons stated above with reference to claim 5.

Claim 12 includes the limitation of the longitudinally extending passage. Therefore, claim 12 includes all of the canceled subject matter of original claim 1 and thus is not broader than the original claim and thus avoids the recapture rule.

Claim 16 includes all of the elements of original claim 1. Claim 16 is narrower than the claims canceled or amended in the original application with regards to the guide - an aspect germane to the prior art rejection. Specifically, the guide of claim 16 requires "a pair of transversely spaced opposing legs." Claim 16 has been amended to include the longitudinally extending passage, however it is broadened wherein the passage is formed by one of the track and the pair of opposing legs, rather than being formed by the track as originally claimed. The passage has also been narrowed because the passage is either formed by the pair of opposing legs or receives a portion of the pair of opposing legs.

Although the passage has been included in claim 16 and is both broader and narrower than the passage as originally claimed, the broadening is not limited by recapture because the passage limitation was not argued to overcome the prior art. Accordingly, under *Pannu*, Applicants are not estopped by prosecution history from this broadening. Additionally, Applicants' narrowing of the passage, which requires it to be formed in the pair of opposing legs or receiving a portion thereof, is material to the broadening of the passage.

Claims 19-20 and 23-27 depend from claim 16 and therefore overcome the recapture rejection for at least the reasons stated above with reference to claim 16.

According to the Examiner, "claim 29 of this application narrows the surrendered subject matter of application claim 1 in a manner not related to the surrender limitations listed above and thus is subject to recapture by the above analysis." (Non-final Office Action of April 29, 2004, page 5). The Examiner is incorrect. Claim 29 is narrower than the surrendered subject matter in all aspects, and therefore the recapture rule does not apply according to *Eggert*, 67 U.S.P.Q.2d at 726 and *Clement* at 1769-70, 45 U.S.P.Q.2d at 1165.

Claim 31 is broader than original claim 1 because the longitudinally extending passage is formed by the pair of opposing legs rather than by the track. This is not impermissible broadening under *Pannu* because the track was not included nor argued to overcome the prior art in the prosecution history of the issued patent. Further, the passage is narrow with regards to the original claim 1 because the passage is formed in the pair of opposing legs and receives a portion of the track.

The Examiner's recapture rejection fails to rebut Applicant's arguments regarding the prior recapture rejection. The Examiner's reliance on Drawing 1 of *Eggert* mischaracterizes the Board's interpretation of the drawing and the case law regarding the recapture rule altogether. Applicant respectfully requests that the Examiner reconsider the recapture rejection of claims 5-17, 19-20, 23-27, 29 and 31 and withdraw the rejections for the reasons stated above.

***Claim Rejections - 35 U.S.C. § 102***

The Examiner has rejected claims 5-7, 13, 14-16, 19, 23-24 and 26-27 under 35 U.S.C. § 102(b) as being anticipated by Clark.

With reference now to claim 5, a marked up copy as amended by this paper is attached below.

5. (Currently Amended) A sliding sun visor assembly comprising:  
a rod assembly including:  
a longitudinally extending rod;  
a torque control pivotally attached to said rod,  
and a guide fixed to one surface of said torque control, the guide having a pair of opposing legs extending transversely away from said rod, the legs defining a longitudinal slot therebetween; and  
a visor body including:  
a structure projecting therefrom defining a longitudinally extending bore for receiving said rod, and

a longitudinally extending track being shaped to receive a portion of said guide, wherein the track cooperates longitudinally between the pair of opposing legs of said guide in a sliding engagement within the slot, whereby upon moving the visor body longitudinally along said rod, said track slides relative to said guide.

Support for this change is provided in Figures 2, 3, 6 and 7 in the accompanying text beginning at column 2, line 49.

Claim 5 requires "a pair of opposing legs extending transversely away from said rod, the legs defining a longitudinal slot therebetween...wherein the track cooperates longitudinally between the pair of opposing legs of said guide in a sliding engagement within the slot." The Examiner indicates that track 72, 74 cooperates with legs 58 and apertures 59 of Clark. However, the legs of Clark extend transversely towards rather than away from the rod. Additionally, the legs of Clark do not define a longitudinal slot therebetween and the track does not cooperate within the slot. Rather the track passes through apertures 59 formed through the legs. Accordingly, claim 5 does not read on Clark and therefore is not anticipated thereby.

Claims 6-7, 13 and 14-15 depend from claim 5 and therefore are not anticipated by Clark for at least the reasons stated above with reference to claim 5.

Claim 16 requires "a pair of transversely spaced opposing legs." In contrast, Clark includes a pair of longitudinally spaced legs. Further, claim 16 requires "one of said track and said pair of opposing legs of said guide form a substantially enclosed longitudinally extending passage...to receive a portion of the other of said track and said pair of opposing legs." The track referred to by the Examiner, guide rod 72, 74, does not include such a passage. The pair of legs 58 of Clark do not include such a passage either, rather each include a pair of apertures 59 for receiving the associated guide rods. The apertures are not longitudinally extending, rather are longitudinally spaced and have a longitudinal dimension defined by the thickness of the material of the associated leg (walls 58) and therefore do not

satisfy the passages claimed. The Examiner stated that no definitive frame of reference for 'laterally' is recited. Therefore, Applicant has replaced this term with 'transversely', which is understood as being generally perpendicular to 'longitudinally'. Accordingly, claim 16 does not read on Clark and therefore is not anticipated thereby.

Claims 19, 23-24, 26-27 depend from claim 16 and therefore are not anticipated by Clark for at least the reasons stated above with reference to claim 16.

The Examiner has not stated that claim 29 is rejected under 35 U.S.C. § 102(b) as being anticipated by Clark. However, on page 6, the Examiner refers to claims 29 in the listing of claims 15, 27 and 29. Yet, in the response to arguments, the Examiner states “[t]he comments regarding the Clark reference in claim 29 are agreed with.” Therefore, Applicant believes the reference to claim 29 in the first sentence on page 6 is a typographical error. However, if the Examiner is rejecting claim 29 under 35 U.S.C. § 102, Applicant reasserts that Clark does not provide a slot and passage found in the legs and track respectively, as required in claim 29. Therefore, claim 29 is not anticipated by Clark.

In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw all anticipation rejections.

#### ***Allowable Subject Matter***

Applicant appreciates the Examiner's indication that claims 1-4 are allowed.

#### ***Response To Arguments***

The Examiner states “[n]o comments regarding claim 31 in the applied reference are noted.” However, no references were applied to claim 31 in the Office Action of October 3, 2003. Additionally, no references have been applied to claim 31 in the Office Action of April 29, 2004.

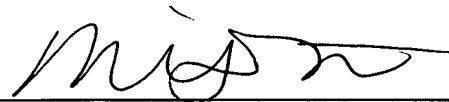
***Conclusion***

In view of the foregoing, Applicant respectfully asserts that the claims are in condition for allowance, which allowance is hereby respectfully requested. A check in the amount of \$110.00 is enclosed to cover the petition fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978--a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

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